

REMARKS

Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

The Examiner's communication of October 20, 2005, together with the references cited therein, have been given careful consideration. After such consideration, and in an earnest effort to complete the prosecution of this application, the Applicant has set down the following arguments in support of claims 1-20.

Claims 1-10 have been allowed. Claims 12 and 20 have been indicated as containing allowable subject matter. Claims 11 and 13-19 have been rejected over Applicant's stated Background in view of Farrow, US 4,191,995.

To assist the Examiner in reconsidering this application, the following is a presentation based on the language employed in claim 11 when read on the embodiment presented in Figs. 1-7 herein. Claim 11 recites a computer program product for determining signal attenuation for an electronic support measure receiver. The computer program product includes: a first instruction for receiving electromagnetic signals from a surrounding environment; a second instruction for chronologically segregating the electromagnetic signals into a plurality of dwells; a third instruction for controlling the processing of the plurality of dwells; a fourth instruction for determining an analysis dwell from the plurality of dwells; and a

fifth instruction for computing a coarse attenuation for the analysis dwell.

The Office Action (page 1) states that the Background does not disclose a coarse attenuation. The Office Action (page 1) states that Farrow determines a coarse attenuation and that it would have been obvious to modify the Background to include the coarse attenuation of Farrow in order to help prevent detection of too much signal.

The M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

See, MPEP §706.02(j) citing *In re Vaeck*, 947 F.3d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991)..

In rejecting claim 11 as obvious over the Background in view of Farrow, the Office Action states that one would have been motivated to modify the Background to include the coarse attenuation of Farrow in order to help prevent detection of too much signal (Office Action, page 2). The Office Action cites no section of the Background or Farrow.

The structure of a computer programmed to carry out an algorithm is limited by the disclosed algorithm. See WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a special purpose computer) is created when a computer is programmed to carry out an algorithm for performing one or more new functions. Id. citing In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a computer is programmed to perform a particular function by using a discovery not specified in the prior art, the resulting device would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply would not know what to program the computer to do." See In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious. In Re Spinnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original).

Accordingly, the Examiner must consider only the teachings of the prior art references. The Background fails to teach computing a coarse attenuation. Therefore, it is clear that the features of claim 11 are not taught by the Background. According to WMS Gaming Inc., 184 F.3d at 1348,

the structure of the computer program product of claim 11 is the algorithm for carrying out the program. Since the Background fails to teach or suggest these features, the Background fails to teach or suggest a computer having the structure of the computer program product of claim 11. Since the Background fails to teach or suggest each feature of the claimed invention, it is respectfully submitted that the invention of claim 11 would not have been obvious to one of ordinary skill in the art.

Additionally, when an algorithm is not taught or suggested by the prior art, one of ordinary skill in the art would not know what to program a computer to do. See e.g., In re Prater, 415 F.2d at 1397-98. Thus, a new machine has been created when a computer is programmed to carry out an algorithm to perform a new function, as in claim 11. WMS Gaming Inc., 184 F.3d at 1348. Therefore, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art to modify the Background with Farrow.

Furthermore, in rejecting claim 11 as obvious over The Background in view of Farrow, it is respectfully suggested that improper hindsight has been used. The prior art fails to teach or suggest the computer program product of claim 11. Thus, without reference to the teachings of the disclosure of the present invention, one of ordinary skill in the art would not have the requisite knowledge to modify the Background.

According to In Re Sponnoble, 160 USPQ at 243 (CCPA 1969), such hindsight is impermissible. Therefore, it is

respectfully submitted that for this further reason, the rejection of claim 11 is improper.

Claim 11, as well as claims 12-15 which depend from claim 11, are in condition for allowance.

To assist the Examiner in reconsidering this application, the following is a presentation based on the language employed in claim 16 when read on the embodiment presented in Figs. 1-7 herein. Claim 16 recites a method for determining signal attenuation for an electronic support measure receiver. The method includes the steps of: receiving electromagnetic signals from a surrounding environment; chronologically segregating the electromagnetic signals into a plurality of dwells; controlling the processing of the plurality of dwells; determining an analysis dwell from the plurality of dwells; computing an update attenuation of the analysis dwell; determining whether a new analysis dwell is required; and computing a coarse attenuation of the new analysis dwell.

The Office Action (page 1) states that the Background does not disclose a coarse attenuation. The Office Action (page 1) states that Farrow determines a coarse attenuation and that it would have been obvious to modify the Background to include the coarse attenuation of Farrow in order to help prevent detection of too much signal.

The M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

See, MPEP §706.02(j) citing *In re Vaeck*, 947 F.3d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991)..

In rejecting claim 16 as obvious over the Background in view of Farrow, the Office Action states that one would have been motivated to modify the Background to include the coarse attenuation of Farrow in order to help prevent detection of too much signal (Office Action, page 2). The Office Action cites no section of the Background or Farrow.

A method for carrying out an algorithm is limited by the disclosed algorithm. See WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a special purpose computer) is created when a computer is programmed to carry out an algorithm for performing one or more new functions. Id. citing In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a computer is programmed to perform a particular method by using a discovery not specified in the prior art, the resulting method would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply would not know

what to program the computer to do." See In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious. In Re Spinnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original).

Accordingly, the Examiner must consider only the teachings of the prior art references. The Background fails to teach computing a coarse attenuation. Therefore, it is clear that the features of claim 16 are not taught by the Background. According to WMS Gaming Inc., 184 F.3d at 1348, the method of claim 16 is the algorithm for carrying out the method. Since the Background fails to teach or suggest these features, the Background fails to teach or suggest the method of claim 16. Since the Background fails to teach or suggest each feature of the claimed invention, it is respectfully submitted that the invention of claim 16 would not have been obvious to one of ordinary skill in the art.

Additionally, when an algorithm is not taught or suggested by the prior art, one of ordinary skill in the art would not know what method step to perform. See e.g., In re Prater, 415 F.2d at 1397-98. Thus, a new machine has been

created when a method carries out an algorithm to perform a new function, as in claim 16. WMS Gaming Inc., 184 F.3d at 1348. Therefore, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art to modify the Background with Farrow.

Furthermore, in rejecting claim 16 as obvious over the Background in view of Farrow, it is respectfully suggested that improper hindsight has been used. The prior art fails to teach or suggest the method of claim 16. Thus, without reference to the teachings of the disclosure of the present invention, one of ordinary skill in the art would not have the requisite knowledge to modify the Background.

According to In Re Sponnoble, 160 USPQ at 243 (CCPA 1969), such hindsight is impermissible. Therefore, it is respectfully submitted that for this further reason, the rejection of claim 16 is improper.

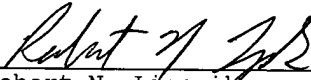
Claim 16, as well as claims 17-20 which depend from claim 16, are in condition for allowance.

Allowance of the subject application is respectfully requested.

Serial No. 10/308,764

Please charge any deficiency or credit any overpayment in
the fees for this election to our Deposit Account No. 20-0090.

Respectfully submitted,


Robert N. Lipcsik
Reg. No. 44,460

TAROLLI, SUNDHEIM, COVELL,
& TUMMINO, LLP
526 Superior Avenue - Suite 1111
Cleveland, Ohio 44114-1400
Phone: (216) 621-2234
Fax: (216) 621-4072
Customer No. 26294